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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,920	03/16/2001	Steven P. Bitler	12969-1	7133

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EXAMINER

SZEKELY, PETER A

ART UNIT	PAPER NUMBER
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1714

15

DATE MAILED: 11/21/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

mk-15

Office Action Summary

Application No.

09/810,920

Applicant(s)

BITLER ET AL.

Examiner

Peter Szekely

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 October 2002 and 17 October 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9-58 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1714

DETAILED ACTION

Specification

1. The amendment filed 07/12/02 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material, which is not supported by the original disclosure, is as follows: "The polymeric thickener should be used in an amount sufficient to thicken the oil." See page 10, line 14, of the amended specification. Furthermore, the incorporation by reference of the prior art, listed on page 1, lines 19-20, of the specification, by amendment, is also new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-5, 9-12, 20, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. There is no mention in the original specification of a side chain crystalline polymer "being present in an amount such that it thickens the oil." This is new matter. The incorporation by reference of Morawski et al. 5,736,125 does not alleviate the problem, since incorporation by reference after the filing date is new matter also.

Art Unit: 1714

4. Claims 1-5, 9-12, 20, 37 and 38 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. There is nothing in the original specification to guide one of ordinary skill in the art, to determine the concentration range at which the polymer thickens the oil. Undue experimentation is needed to determine the effective range, which can be any range between 0% and 100% by weight.
5. Claims 21-25, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "at least 2% by weight" concentration level of the SCCP cannot be found in the specification. This is new matter.
6. Claims 21-25, 39 and 40 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the 2-10% by weight concentration range of the SCCP, does not reasonably provide enablement for the 2-100% by weight of the SCCP. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. See page 10, lines 14-18 of the original specification. The specification teaches away from the use of more than 10% by weight of the SCCP.

Art Unit: 1714

7. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The "at least 0.5% by weight" concentration level of the SCCP cannot be found in the specification.

8. Claim 31 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for 0.5-5% by weight concentration range of the SCCP, does not reasonably provide enablement for a 0-100% by weight concentration range of the SCCP. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make or use the invention commensurate in scope with these claims. See page 10, lines 14-18 of the original specification.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Art Unit: 1714

10. Claims 1-7 and 9-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2, 3, 5, 7-14 and 17-39 of copending Application No. 09/398,377. Although the conflicting claims are not identical, they are not patentably distinct from each other because they cover the same subject matter featuring identical compositions and overlapping concentrations.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

12. Claims 1-5, 9-12, 20, 37 and 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller 5,281,329.

Claim Rejections - 35 USC § 103

13. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

14. Claims 1-5, 9-12, 20, 32-38, 43 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller 5,281,329.

Response to Arguments

15. Applicant's arguments filed 10/03/02 and 10/17/02 have been fully considered but they are not persuasive. The Declaration of Dr. Steinberg has no probative value

Art Unit: 1714

since it constitutes only an opinion of someone who is not one of ordinary skill in the art. Anticipating the removal of the new matter from the specification and from the claims, all rejections made in Papers #4, #8 and #10 are maintained. Mueller et al. does not use the SCCP as a thinner. It is used as a pour point depressant, i. e. antifreeze. The use of a pour point depressant does not lower the viscosity, it might even raise it at the ambient temperature, it just does not let the viscosity to increase when the temperature drops. The statement that "the SCC polymer is present in an amount such that it thickens the oil means what it says" is confusing. The whole basis for the rejections is that the examiner does not know what the phrase says. The amount of SCCP needed to thicken the oil is not known. As far as the petroleum oils are concerned, the operative word is "predominantly". Mineral oil and vaseline oil are petroleum oils; the pour point depression of them would be obvious. In an interview with Mr. Sheldon the examiner indicated that the method of using the SCCP as a thickener might be allowable. On reconsideration however, this statement was found to be erroneous, since the method steps would be no different from the method of Mueller et al., namely blending the SCCP into the oil.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is 703-308-2460. The examiner can normally be reached on Tuesday-Friday 7:00 a.m.-5:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 703-306-2777. The fax phone numbers for the organization where this application or proceeding is assigned are 703-

Art Unit: 1714

872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
November 20, 2002